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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,584	12/21/2001	Craig A. Rosen	PF112P1D2	4809

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EXAMINER

LANDSMAN, ROBERT S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 07/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,584

Applicant(s)

ROSEN ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-110 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *1. Election/Restriction*

A. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19 and 22-50, drawn to an antibody to various fragments of SEQ ID NO:2 as well as cells and hybridomas, classified in class 530, subclass 387.1.
- II. Claims 20, 21 and 51, drawn to a method of using an antibody, classified in class 435, subclass 7.1.
- III. Claims 52-66, 69-89 and 97-110, drawn to an antibody to various fragments, or forms, of ATCC 97149, as well as cells and hybridomas, classified in class 530, subclass 387.1.
- IV. Claims 67, 68 and 90, drawn to a method of using an antibody, classified in class 435, subclass 7.1.
- V. Claim 91, drawn to a method of inhibiting angiogenesis in a patient by administering antibody, classified in class 514, subclass 2.
- VI. Claim 92, drawn to a method of inhibiting neovascularization in a patient by administering antibody, classified in class 514, subclass 2.
- VII. Claim 93, drawn to a method of inhibiting a tumor in a patient by administering antibody, classified in class 514, subclass 2.
- VIII. Claim 94, drawn to a method of inhibiting diabetic retinopathy in a patient by administering antibody, classified in class 514, subclass 2.
- IX. Claim 95, drawn to a method of inhibiting psoriasis in a patient by administering antibody, classified in class 514, subclass 2.
- X. Claim 96, drawn to a method of inhibiting rheumatoid arthritis in a patient by administering antibody, classified in class 514, subclass 2.

B. The inventions are distinct, each from each other because of the following reasons:

Inventions I and III are independent and distinct, each from each other, because they are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged.

Inventions I and III are related to Inventions II and IV-X as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product, or (2) the product as claimed can be used in a materially different process of using that product MPEP § 806.05(h).

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Inventions II and IV-X are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

The product claims of Groups I and III recite numerous individual fragments of SEQ ID NO:2, or of the protein encoded for by ATCC 97149. Therefore, the antibodies which bind these independent and distinct fragments would be independent and distinct. Therefore, if Applicants elect Group I or III, to be fully responsive, Applicants must elect one fragment (i.e. parts (a) – (h)) to be searched from the independent claims. Once this is done, the remaining claims will be reviewed and the pertinent claims will be searched as well. Similarly, if Applicants elect a method from Groups II or IV-X, they must elect a specific fragment of SEQ ID NO:2 or ATCC 97149 to be searched. Since ATCC 97149 encodes SEQ ID NO:2, the corresponding antibodies or methods elected by Applicants will be searched together as long as the fragments encoded by each are identical. As written, it does not appear that many of the claimed antibodies to the ATCC deposit correspond to the claimed fragments of SEQ ID NO:2.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

C. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

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***Advisory information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D.

Patent Examiner

Group 1600

July 23, 2003

  
ROBERT LANDSMAN  
PATENT EXAMINER